

**REMARKS**

Favorable reconsideration is requested in view of the foregoing amendments and the following remarks.

**I. Claim Status and Amendments**

Claims 9-18 were pending in this application when last examined.

Claims 9, 10, 15, and 16 stand rejected.

Claims 11-14, 17, and 18 are objected to as being based on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. See page 3 of the Official Action. Applicants appreciate the Examiner's indication of allowable subject matter. Kindly note that claims 11 and 17 have been rewritten in independent form as suggested by the Official Action. Claims 12-14 depend on claim 11. Claim 18 depends on claim 17. Accordingly, claims 11-14, 17, and 18 should now be in condition for allowance.

Applicants have amended claims 9-14 and 16-18 in a non-narrowing manner to make minor editorial revisions to better conform to U.S. claim form and practice. Such revisions are non-substantive and not intended to narrow the scope of protection. The revisions include: replacing the "characterized by" language with "wherein"; revising the beginning of the claims to recite "A" or "The"; and revising

the claim language to provide proper antecedent basis throughout the claims. The revisions should not alter the scope of protection. Nor should they alter the status of the subject matter indicated as allowable.

No new matter has been added by the above claim amendments.

Claims 9-18 are pending upon entry of this amendment.

The specification is amended to include appropriate section headings to conform to U.S. practice. No new matter has been added.

The above claim amendments are intended to address matters of form only as they are not intended to affect the scope of the claims. Accordingly, it is believed that the present amendment does not present any new issues for consideration and/or search as the amended claims correspond to subject matter already considered by the Office. Thus, if the next Office Action on the merits includes a new ground of rejection of one or more claims, the Action must be non-final.

## **II. Foreign Priority Claim**

Acknowledgment has been made of the claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). However, the Official Action indicates that none of the certified copies of the foreign priority documents have been

received at the USPTO. See item 12(c)1 of the Office Action Summary.

Applicants respectfully disagree and submit that certified copies of the foreign priority documents were submitted by the International Bureau. Kindly review the USPTO files for the certified copies and acknowledge receipt of such.

### **III. Prior Art Rejections**

Claims 9, 10, and 16 were rejected under 35 U.S.C. § 102(b) as anticipated by Baxter et al. (U.S. 5,309,820) for the reasons on pages 2 of the Office Action.

Claim 15 was rejected under 35 U.S.C. § 103(a) as being obvious over Baxter et al. (U.S. 5,309,820) in view of Blanc (U.S. 6,595,108) for the reasons on pages 2-3 of the Office Action.

These rejections are respectfully traversed and will be discussed together below, since Baxter et al. is the primary reference used in each rejection.

#### **Baxter et al.**

It is respectfully submitted that he anticipation rejection over Baxter et al. falls, because Baxter et al. fails to meet each and every element of independent claims 9 and 16, as required for anticipation. It is well established that to anticipate a claim, a cited prior art reference must

disclose each and every element of the claimed invention. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); and M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2131.

It seems that the Office has misunderstood the teachings of Baxter et al. as compared to the instantly claimed invention.

In the instant application, claim 9 is directed to a device for production of a beverage by infusion of a ground product. The device comprises "an infusion chamber (2) able to receive the ground product, a circuit of hot water crossing the infusion chamber (2), and a means for circulating the hot water in the circuit, wherein the circulation means is reversible so that the hot water can be circulated through the infusion chamber (2) during beverage production in the opposite direction."

Accordingly, in the device of claim 9, a circuit of hot water crosses the infusion chamber and the hot water is circulated through the infusion chamber by way of a circulation means (i.e., pump). This circulation means (pump) is adapted to be reversible, so that the direction of circulation of hot water can be reversed. This feature improves the efficiency of the infusion of the ground product in the claimed device. The method of claim 16 also requires this feature.

Baxter et al. fails to disclose or suggest the above-noted feature of the claims.

In the primary reference of Baxter et al., ground coffee is poured within a chamber shaped like a hopper. The chamber is then filled with hot water. See, for instance, the description in col. 14, lines 14-26 of the specification. At this stage, it should be noted that there is no circulation of hot water through the infusion chamber. Rather, the water remains in the chamber and the ground coffee is agitated within the water by an air flow depicted at 34 in figure 5a. Then, at a second stage, the coffee beverage is delivered as depicted in figure 5b. See, for instance, the description in col. 14, lines 27-37 of Baxter et al.

The only similarity between the claimed device and Baxter et al. is that, in Baxter et al., there is provided means for reversing the direction of a flow. But, in Baxter et al., this means is used to first admit air in the infusion chamber and then to deliver the beverage. This stands in contrast to the device of claim 9.

Again, the circulation means of claim 9 of the present application is such that hot water can be circulated through the infusion chamber during beverage production according to two opposite directions. This improves the efficiency of the infusion of the ground product, and it is vastly different from the teachings of Baxter et al.

Indeed, Baxter et al. mentions nothing a means for circulating hot water through the infusion chamber, let alone, one that is reversible so that circulation through the infusion chamber during beverage production can occur in two opposite directions. Baxter et al. fails to disclose a means for reversing the circulation of the hot water.

Thus, it is clear that Baxter et al. fails to disclose each and every element of the device of claim 9 and the method of claim 16. For this reason, Baxter et al. cannot anticipate these claims nor claims dependent thereon.

Thus, the 102(b) anticipation rejection over Baxter et al. is untenable and should be withdrawn.

Baxter et al. in view of Blanc

As to the obviousness rejection of claim 15 over Baxter et al. in view of Blanc, it is first noted that claim 15 depends on claim 9. Consequently, the coffee machine of claim 15 requires each and every element of the device of claim 9.

The rejection should fall, because the secondary reference of Blanc fails to remedy the above-noted deficiencies of Baxter et al. with respect to claim 9 to which claim 15 depends.

The Official Action relied on Blanc for disclosing use of a pre-packaged dose of ground product with an infusion device. However, Blanc mentions nothing a means for

circulating hot water through the infusion chamber, let alone, one that is reversible so that circulation through the infusion chamber during beverage production can occur in two opposite directions. For this reason, it is clear that Blanc does not remedy the deficiency in Baxter et al.

Thus, the rejection fails, because the combination of Baxter et al. and Blanc does not to teach, suggest or make obvious all of the limitations of claim 9 to which claim 15 depends, as required to support a *prima facie* case of obviousness.

Therefore, the obviousness rejection is untenable and should be withdrawn.

#### **IV. Claim Objections & Allowable Subject Matter**

Claims 11-14, 17, and 18 were objected to as being based on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. See page 3 of the Official Action. Applicants appreciate the Examiner's indication of allowable subject matter.

The present amendment overcomes this objection by re-writing claims 11 and 17 to independent form. Claims 12-14 depend on claim 11. Claim 18 depends on claim 17. Accordingly, claims 11-14, 17, and 18 are now be in condition for allowance.

**V. Conclusion**

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance and early notice to that effect is hereby requested. If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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